

REMARKS/ARGUMENTS

Claims 1-53 are pending in this application and are rejected under 35 U.S.C. § 103.
Claims 1, 2, 17, 32, 36, 45, and 53 are currently amended.

For at least the reasons set forth below, Applicants assert that all claims are in condition for allowance.

Double Patenting Rejection

Claims 1-53 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-6, 10-18, 46-47, 19-20, 29-31, 33-34, 36, 38, and 45 of U.S. Patent Application No. 09/783,660 in view of Simonoff et al., U.S. Pat. No. 6,078,322. A terminal disclaimer was filed with Applicants' Amendment and Response dated November 17, 2005, but Examiner indicated that the terminal disclaimer was not accepted.

Applicants are currently working to obtain a new terminal disclaimer signed by an authorized person and fully expect to obtain such terminal disclaimer to overcome the nonstatutory double patenting rejection, thereby obviating this rejection. In the meantime, Applicants respectfully request that this rejection be held in abeyance.

Declaration of Prior Invention Under 37 CFR § 1.131

Included with Applicant's Amendment and Response dated November 17, 2005, was a 37 CFR § 1.131 declaration swearing back of the *Patrick* reference and effectively antedating the reference in accordance with MPEP § 715. Examiner asserted that the declaration was ineffective to overcome the *Patrick* reference because "diligence is lacking from October 23, 2000 to at least the publication date of the *Patrick* reference dated 1/30/2001." Applicants respectfully disagree, and it is unclear to Applicants why documentation disclosed with the declaration and dated after 10/23/2000 but before 1/30/2001 did not demonstrate due diligence between those dates. However, because the rejection relying on the *Patrick* reference was withdrawn and no longer forms part of the current rejection, Applicants believe this issue does not require disposition at this time.

Rejection under 35 U.S.C. § 103

Claims 1-13 and 17-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Filepp et al. U.S. 5,347,632 in view of Kikinis U.S. 5,727,159. Applicants respectfully request reconsideration of these claims and request that the rejection be withdrawn at least because (a) these references fail to teach or suggest all of the claim limitations as required by MPEP § 2143, and (b) these references are not properly combinable.

(a) UI Form Based On Client Device Capabilities

Independent claims 1, 17, 32, 36, and 45 recite defining or generating a user interface form based upon or being dictated by a number of device capabilities for a client device. Specifically, claims 1, 32, 36, and 45 recite a UI form based upon a number of device capabilities for the client device “including a client device operating system, a client device maximum receivable packet size, and a list of available client device native UI controls,” and claim 17 similarly recites that the device capabilities include “a client device operating system and a client device maximum receivable packet size.”

Examiner agrees that *Filepp* fails to teach these limitations (see, OA dated 1/30/06, p. 4, “*Filepp* does not explicitly say generating according to a UI format that is based upon a number of device capabilities for said client device”), but rather the rejection relies on *Kikinis* as teaching this limitation. Specifically, the rejection cites passages in *Kikinis* at Col. 2, lines 48-51 and Col. 10, lines 20-33, which state, “In various embodiments of the invention the Proxy-Server downloads data comprising WEB pages and transposes the data to match the specific size and resolution of the display of the field computer” and “At step 101 the Proxy-Server converts all of the .jpg files to a dithered bitmap format according to information associated with the user ID received from the hand-held at log-on. This ID establishes the size and resolution of the hand-held’s display, for example, and the bitmap created from the .jpg files is scaled to the hand-held’s display” respectively. (emphasis added). However, the reference only describes converting electronic image file formats according to a client device’s display size and resolution.

In contrast, the claims of the present invention as amended require a UI form based upon a number of device capabilities for the client device including a client device operating system, a client device maximum receivable packet size, and a list of available client device native UI controls. These recited capabilities do not read on a client device's display size and resolution, which are taught by Kikinis. Moreover, the recited capabilities are not taught by the remaining art of record, which does not disclose a UI form based on such capabilities suitable for thin client devices.

(b) Filepp and Kikinis References Are Not Properly Combinable

Moreover, the *Filepp* and *Kikinis* references are not properly combinable because the *Filepp* reference teaches away from being modified or combined with other references to achieve the present claimed invention:

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

In re Gurley, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130, 1131 (Fed.Cir.1994). The Court also noted that there is “no suggestion to combine” references where one reference deliberately seeks to avoid a teaching of the other reference. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed.Cir.1988). When deliberating on prior art, “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP § 2141.02 (VI).

In the present application, whereas *Filepp* is directed towards an architecture that reduces the load on the server and provides for a fat client (i.e., client that performs the bulk of the data processing operations), *Kikinis* and the present invention are directed towards an architecture that reduces the load on the client and provides for a thin client (i.e., server that performs the bulk of the data processing operations, *see* Col. 2, lines 26-36; Col 6, lines 6-36). Accordingly, considering each reference “in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention,” one skilled in the art would not reasonably combine *Filepp* with *Kikinis*, or any other reference, to teach or suggest the limitations of the present claimed invention. MPEP § 2141.02 (VI).

The present invention is directed towards a thin client architecture, where substantial proportions of the processing are performed server-side to reduce the load on the client. See claims 1, 17, 32, 36, and 45; *see, also*, Spec. p. 6, lines 19-21 (“A preferred embodiment of the present invention provides a data communication architecture that exhibits the following attributes: a relatively thin client for reduced client-side resource demands...”) (emphasis added) In stark contrast, *Filepp* is directed towards an architecture that reduces the load on the server and provides for a fat client:

...the invention includes procedures for formulating objects that have been specially structured to include display data, control data and program instructions for supporting the applications at the network reception systems, the objects being pre-created, parceled units of information that may be distributed and stored at lower levels in the network...so as to reduce processing demand on the network higher element...

Col. 2, line 60-Col. 3, line 1 (emphasis added); *see, also* Col. 76, lines 37-47 (“the table can be presented to the user’s RS 400, where the [client-side] RS 400 can provide the data processing required to present the potentially relevant keywords, objects and associated applications to the user...this procedure reduces demand on server...”); *see, also* Col. 1, lines 16-25 (“This invention relates generally to a distributed processing...computer network in which the interactive text/graphic sessions are comprised of pre-created blocks of data and program instructions which may be distributed downwardly in the network for use at a software enhanced user computer terminal that reduces processing demand on the higher-level network elements...”); *see, also* Col. 75, lines 41-56 (“the method aspect of the invention includes an improved procedure for searching and retrieving applications from the store of applications distributed throughout network...this reduces the demand on the server...”).

Accordingly, *Filepp* teaches away from being modified or combined with other references to achieve the present claimed invention. One of ordinary skill in the art would not be motivated to combine the *Filepp* (fat client) reference with *Kikinis* (thin client) to achieve the present claimed invention because the data processing allocation of each these references are incompatible. Considering the *Filepp* reference “in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention,” one skilled in the art would not reasonably combine *Filepp* and *Kikinis*.

This application now stands in allowable form and reconsideration and allowance is respectfully requested.

Respectfully submitted,

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